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| 10/650,837      | 08/27/2003  | Jason Edward Gibson  | 200309117-1         | 7413             |

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| EXAMINER |
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PARK, CHAN S

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| ART UNIT | PAPER NUMBER |
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2625

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09/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                               |                                      |  |
|------------------------------|-------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/650,837 | Applicant(s)<br>GIBSON, JASON EDWARD |  |
|                              | Examiner<br>CHAN S. PARK      | Art Unit<br>2625                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.


**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

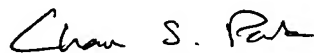
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/27/03.

  
**DOUGLAS Q. TRAN**  
**PRIMARY EXAMINER**

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



## **DETAILED ACTION**

### ***Claim Objections***

1. Claims are objected to because of the following informalities:

Claim 1, line 2, "based an identifier" should be -- based on an identifier --;

Claim 4, line 2, "a print job" should be -- said print job --;

Claim 19, line 2, "with printing device" should be -- with said printing device --;

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 44 and 45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Refer to page 53 of the Interim Guideline. The examiner suggests using the term -- A computer readable medium having computer executable instructions -- instead of "A controller readable medium having instructions".

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 3, 26 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 3 recites the limitation "retrieving settings". There is insufficient antecedent basis for this limitation in the claim. It is unclear if these retrieved settings are different from *the obtained settings* recited in claim 2.

4. Claim 26 recites the limitation "the source location of said data". There is insufficient antecedent basis for this limitation in the claim.

5. With respect to claim 31, arguments analogous to those presented for claim 3, are applicable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9, 16-19, 21, 24-26, 28-35, 37 and 42-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimoosawa.

6. With respect to claim 1, Shimoosawa teaches a method of configuring a printing device (fig. 1 & abstract), said method comprising:

dynamically modifying printing device settings based on an identifier in an incoming job identifying a client submitting said print job (col. 5, lines 13-52 & col. 11, lines 16-50).

7. With respect to claim 2, Shimoosawa teaches the method of claim 1, further comprising:

scanning data packets of said print job for said identifier (col. 4, lines 57-59);

querying a database (storage storing the table in fig. 4) to obtain settings for said printing device associated with said identifier (col. 5, lines 20-37); and

configuring said printing device according to said settings associated with said identifier (figs. 8~10 & col. 11, lines 16-50).

8. With respect to claim 3, Shimoosawa teaches the method of claim 2, wherein said querying a database comprises:

determining a location associated with said identifier (col. 3, lines 61-67); and

retrieving settings for said printing device associated with said location (col. 3, lines 61-67). It is inherent that the proper storage and location are determined first in order to retrieve the transfer attribute 53 in fig. 4. Also, note that each sender ID is associated with each transfer attribute stored in the respective storage location.

9. With respect to claim 4, Shimoosawa teaches the method of claim 2, wherein said configuring said printing device occurs automatically when said print job is received (col. 11, lines 33-42).

10. With respect to claim 5, Shimoosawa teaches the method of claim 2, wherein said scanning comprises searching header data for said identifier (col. 4, lines 57-59).

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11. With respect to claim 6, Shimoosawa teaches the method of claim 2, further comprising storing said identifier in printing device memory (note that the email address must be stored first, either permanently or temporarily in order to be compared with sender ID in fig. 4).

12. With respect to claim 7, Shimoosawa teaches the method of claim 2, wherein said database is organized such that each identifier is associated with a set of printing device settings (fig. 4).

13. With respect to claim 9, Shimoosawa teaches the method of claim 2, wherein said database is stored in printing device memory (col. 3, line 61 – col. 4, line 2 & col. 12, lines 23-31).

14. With respect to claim 16, Shimoosawa teaches the method of claim 1, further comprising determining a group to which said printing device belongs based on said identifier (a group belongs to \*@rdmg.mgcs.or.jp in col. 5, lines 20-28).

15. With respect to claim 17, Shimoosawa teaches the method of claim 16, further comprising configuring said printing device according to setting specified for members of said group (col. 5, lines 20-28).

16. With respect to claim 18, Shimoosawa discloses a printing device comprising:  
an input for receiving a print job (col. 5, lines 20-52); and  
a print engine configured to produce a hardcopy from said print job (col. 11, lines 16-50);

wherein said printing device extracts an identifier from said print job and adjusts printing device configuration settings based on said identifier (col. 5, lines 13-52 & col. 11, lines 16-50).

17. With respect to claim 19, Shimoosawa discloses the printing device of claim 18, further comprising a database associating identifiers with printing device configuration settings (figs. 4 & 8~10; col. 11, lines 16-50).

18. With respect to claim 21, Shimoosawa discloses the printing device of claim 19, wherein said database is stored in a memory unit of said printing device (note that the email address must be stored first, either permanently or temporarily in order to be compared with sender ID in fig. 4).

19. With respect to claim 24, Shimoosawa discloses the printing device of claim 18, further comprising a programmable controller programmed to scan data packet headers for said identifier (col. 4, lines 57-69).

20. With respect to claim 25, Shimoosawa discloses the printing device of claim 20, wherein said programmable controller is programmed to query a database to obtain identification information (transfer ID 52 in fig. 4) associated with said identifier.

21. With respect to claim 26, Shimoosawa discloses the printing device of claim 20, wherein said programmable controller is programmed to determine the source location of said data packet based on said identification information (the email address gives who the sender is).

22. With respect to claim 28, Shimoosawa discloses the printing device of claim 18, further comprising a user interface (fig. 1).

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23. With respect to claims 29-35, 37, 42 and 43, arguments analogous to those presented for claims 1-7, 9, 16 and 17 respectively, are applicable.

24. With respect to claim 44, arguments analogous to those presented for claims 1 and 2, are applicable.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 2 above, and further in view of Sims et al. U.S. Patent No. 5,434,775 (hereinafter Sims).

25. With respect to claim 8, Shimoosawa discloses the printing device of claim 2, wherein said database is organized such that each identifier is associated with a set of printing device settings (fig. 4).

Shimoosawa, however, does not explicitly disclose that each identifier is associated with a client location.

Sims, the same field of endeavor of the facsimile art, discloses a data management computer having a database for storing fax number with its associated location (col. 16, lines 25-32).



At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the database of Sims into the printing system of Shimoosawa.

The suggestion/motivation for doing so would have been to provide the user with information regarding the physical location of the destination of the print job.

Therefore, it would have been obvious to combine Shimoosawa with Sims to obtain the invention as specified in claim 8.

26. With respect to claim 13, the combination teaches the method of claim 8, wherein said database comprises a physical location corresponding to each identifier (col. 16, lines 25-32 of Sims).

27. With respect to claim 14, the combination teaches the method of claim 13, wherein said physical location comprises a room number or floor number (col. 16, lines 25-32 of Sims).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 18 above, and further in view of Sims.

28. With respect to claim 20, arguments analogous to those presented for claims 2 and 8, are applicable.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 30 above, and further in view of Sims.

29. With respect to claim 36, arguments analogous to those presented for claim 8, are applicable.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 30 above, and further in view of Sims.

30. With respect to claim 45, arguments analogous to those presented for claims 2 and 8, are applicable.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 2 above, and further in view of Shima U.S. Patent Application No. 2004/0098471.

31. With respect to claims 10 and 11, Shimoosawa teaches the method of claim 2, but it does not explicitly teach whether said database is stored on a network server or Internet server.

Shima, the same field of endeavor of setting the printing device based on the setting parameter stored in the database, teaches the method of printing parameters in a database stored in a network/Internet server (paragraphs 70-75 & 86).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the server database for storing the printer parameters into the printing system of Shimoosawa.

The suggestion/motivation for doing so would have been to reduce the cost of internal memory and further provide the printing device with most updated printing device settings associated with the identifier.

Therefore, it would have been obvious to combine Shimoosawa with Shima to obtain the invention as specified in claims 10 and 11.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 19 above, and further in view of Shima.

32. With respect to claims 22 and 23, arguments analogous to those presented for claims 10 and 11, are applicable.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 30 above, and further in view of Shima.

33. With respect to claims 38 and 39, arguments analogous to those presented for claims 10 and 11, are applicable.

Claims 12 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa.

34. With respect to claim 12, Shimoosawa teaches the method of 2, further comprising changing the content of the transfer management table 34 by the user.

Shimoosawa, however, does not explicitly teach the method of requiring authentication to access said database.

The examiner takes an Official Notice that the requiring authentication to access and modify the content of said database is well known in the network security field. One would have been motivated to implement this requiring step to ensure the proper

transmission of the print job via the printing device. Therefore, it would have been obvious to obtain the invention as specified in claim 12.

35. With respect to claim 40, arguments analogous to those presented for claim 12, are applicable.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 2 above, and further in view of Nakaoka et al. U.S. Patent Application No. 2004/0201860.

36. With respect to claim 15, Shimoosawa teaches the method of claim 1, but it does not explicitly teach that said identifier comprises an IP address.

Nakaoka, the same field of endeavor of recognizing the print job sender, teaches the method of identifying the sender by analyzing the IP address (paragraph 80).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the method of identifying the sender by analyzing the IP address into the printing system of Shimoosawa.

The suggestion/motivation for doing so would have been to provide the capability of changing the printing device setting based on the IP address.

Therefore, it would have been obvious to combine Shimoosawa with Nakaoka to obtain the invention as specified in claim 15.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 29 above, and further in view of Nakaoka.

37. With respect to claim 41, arguments analogous to those presented for claim 15, are applicable.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoosawa as applied to claim 18 above, and further in view of Venkatranman et al. U.S. Patent Application No. 2001/0025307 (hereinafter Venkatranman).

38. With respect to claim 27, Shimoosawa discloses the printing device of claim 18, but it does not explicitly disclose that the printing device comprises an embedded web server.

Venkatranman, the same field of endeavor of the network printing/facsimile device, discloses a printing device having an embedded web server for providing a user with the printing device information on a webpage (fig. 1B & paragraph 27).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the web server of Venkatranman into the printing device of Shimoosawa.

The suggestion/motivation for doing so would have been to provide the printing device information to a user on the network.

Therefore, it would have been obvious to combine Shimoosawa with Venkatranman to obtain the invention as specified in claim 27.

**Contact Information**

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



csp  
August 20, 2007

**DOUGLAS Q. TRAN**  
PRIMARY EXAMINER

Chan S. Park  
Examiner  
Art Unit 2625

